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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shah, et al.

Serial No.: 09/324,182

Group Art Unit: 1615

Filed: June 2, 1999

Examiner: Pulliam, Amy

For: Non-Tacky Mascara Composition

REMARKS

In response to Applicants' previous amendments to the claims, the Examiner finds that the definition of the term "extract" in the specification is still inadequate. Previously, the Examiner found that a limitation in the claims including tacky components of the fruit or vegetable is not present therein and Applicants amended the claims to further clarify the inclusion of tacky constituents. The Examiner notes in the present action that pulp and skin present in the extract of the present invention is not present in the claim language. However, one of ordinary skill in the art would understand that in the present invention the tacky constituents of a plant extract include pulp and skin. Further, this is explained in the present specification at page 3, lines 21 to 30.

... The plant extract component can be derived from a fruit or a vegetable or any other similar type of plant, especially fruits or vegetables that are tacky or sticky.

The plant extract ... is prepared using the whole fruit or vegetable that is, for example, ground liquefied, pressed or processed using similar methods such that the whole processed plant is dispersible in a silicone oil. Except for the seeds, no part of the plant is removed or separated from the extract (i.e., the constituents of the fruit or vegetable are not filtered). The whole pulp and skin of the fruit or vegetable are used. ... It has been discovered, however, that the present invention achieves a non-tacky mascara using an unfiltered plant extract dispersed in silicone oil. ...

Thus, Applicants further amend the claims of the present invention to make this specific recitation. Support for this amendment is also provided in the above section cited from the present specification. No new matter is added. With respect to the special meaning given to the term "extract" in the present specification, the Examiner notes that the claims recite "substantially whole" rather than "whole." In response thereto, Applicants refer to the specification wherein it is noted that the seeds of the plant are not included and therefore to use the term "whole" would not take this into consideration. Specifically, at page 3, lines 26 to 27, the specification points that "except for the seeds, no part of the plant is removed from the extract." Therefore, "substantially whole" is more accurate than "whole" in describing the extract of the present invention. With this explanation and with the present amendments having been made Applicants believe that the concerns of the Examiner have been addressed.

The Examiner does not find support in the Pastour reference for the premise that the Pastour plant extract is an active principle isolated from a plant. Applicants find that support in the Pastour reference is found at column 6, lines 3 to 6, wherein it is disclosed that the Pastour compositions can contain active principles such as plant extracts. The question is: what does the statement in the Pastour reference mean to one of ordinary skill in the art when it says "active principles such as plant extracts." The answer posited by the Examiner is that saying, as it does in the Pastour reference, "active principles such as plant extracts" means the Pastour reference considers the plant extract *per se* to be an active principle. However, the answer to this question really depends on what one of ordinary skill in the art would say about the Pastour reference and the Pastour active principle. Therefore, the answer must be based on an examination of the Pastour reference itself and the other active principles that are mentioned in addition to the plant extract. Further, in Examples 4 and 5, active principles are used in the exemplary compositions and provide further evidence of what the Pastour active principle would mean to one of ordinary skill in the art.

First, taking a look at the various types of active principles other than the plant extract it can be seen that active principles are actives isolated from a source (e.g., plant or bacteria) as the term is used by one of ordinary skill in the art and that, therefore, the term active does not include pulp and skin from a substantially whole processed plant. The Pastour reference discloses bacterial extracts, proteins or their hydrolysates and elastin or collagen hydrolysates. The reference to proteins and their hydrolysates is a strong indication that the active principles of the Pastour reference are actives as that term is commonly known and used by one of ordinary skill in the art. This is consistent with the dictionary definition of the term "active principle" submitted herewith. Webster's Encyclopedic Unabridged Dictionary of the English Language, p. 15 (1989). Further, bacterial extracts are used in Examples 4 and 5. Therein, two exemplary bacterial extracts are found, namely VITACELL® and OXYLASTIL®. One of the bacterial extracts, VITACELL®, is a combination of actives as the term is commonly known and used by one of ordinary skill in the art. The VITACELL® contains Maitake mushroom extract, lycopene, polygonum cuspidatum extract containing resveratrol. It is noted on the list of ingredients that the "TOTAL ACTIVES" is of a certain mass. A copy of the list of ingredients is attached herewith. The other bacterial extract is an active principle derived using biotechnology. However, consistent with 1) the types of active principle disclosed in the Pastour reference and 2) the VITACELL® being a combination of actives, one of ordinary skill in the art would know and understand that plant extract as used in the Pastour reference is an active from the plant obtained by extraction. The Pastour reference does not have to disclose what is known and understood by one of ordinary skill in the art.

Since the Pastour reference does not include a special definition for the active principle, the definition is one that would be applied by one of ordinary skill in the art. In the case of the term "active

principle" in the Pastour reference it is clear that this means actives. The Pastour reference takes a general term, namely "active principle", and uses specific examples to define the general term. Thus, the plant extract is a specific example of an active principle (i.e., the active that is extracted from the plant). Consistent with the other active principles described specifically, the plant extract refers to actives extracted from the plant, and does not include pulp and skin from a substantially whole processed plant. Therefore, the Pastour reference fails to disclose the plant extract of the present invention, as amended, which includes the tacky constituents of the plant or vegetable, and in particular, the pulp and skin.

The Examiner offers recommendations as to what additions to the claims will help advance prosecution towards an allowance which Applicants gratefully acknowledge. One of these suggestions is to include the specific fruit and vegetable extracts into the claims to differentiate the known art-related use of the term "extract." However, Applicants firmly believe that inclusion of the pulp and the skin achieves the object of differentiation and that the inclusion of a laundry list of specific fruits and vegetables does nothing to further this object. Further, Claim 30 specifically recites an apple extract and this claim has not been determined to be allowable. In addition, one point of distinction that has continuously not been recognized is the fact that the Pastour reference puts its plant extract/active principle into the aqueous phase. Thus, the claims already have an additional differentiating feature in that the substantially unfiltered whole processed fruit or vegetable extract of the present invention is dispersed in a silicone oil. Because the Pastour reference does not disclose a seedless but otherwise substantially whole processed fruit or vegetable extract of at least the tacky constituents of the fruit or vegetable, and because it does not disclose any type of fruit or vegetable extract dispersed in a silicone oil, it does not anticipate the present invention, as amended. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

The Examiner asserts that the Pastour reference also renders the present invention obvious because the Pastour reference teaches plant extract and according to the Examiner, this includes any and all plants. However, as previously pointed out, the Pastour reference teaches a plant extract as an example of an active principle removed from the other tacky constituents of the plant. So while, the plant extract can include both vegetable and fruit extract, in any and all cases, the extract taken from the vegetable or fruit source is only the active principle, and not its tacky constituents. In the present office action, the Examiner mentions adding additional ingredients to a traditional formulation and discovering that it works just as well as the known formulation is not unexpected. However, the conclusion reached by the Examiner only holds true based on the nature of the additional ingredient and the expectations tied to the additional ingredient. If there is an expectation that the additional ingredient, as it is in the present case, would ruin the functionality

of the formulation, then the logic applied by the Examiner is inapplicable. To the contrary, the logic that applies here is as follows.

1. The addition of tacky ingredients to a traditional mascara formulation would not be expected to result in a mascara that works just as well.

Thus, the achievement of the present invention is surprising and unexpected because it defies the expectation (or logic) that it would not work just as well.


One of ordinary skill in the art would not expect a mascara formula containing whole fruit and vegetable extract with tacky constituents to achieve the desired qualities of a mascara at all, nonetheless to perform comparably to a conventional mascara. However, surprisingly and unexpectedly, the mascara of the present invention containing unfiltered substantially whole processed fruit or vegetable extract (i.e., containing sticky sugary, gummy and tacky pulp) is favorably compared with conventional mascaras that do not contain these ingredients. Applicants submit that the amended claims of the present application satisfy the requirements of 35 U.S.C. §103(a) because the Pastour reference fails to teach or suggest an unfiltered substantially whole processed fruit or vegetable extract of tacky constituents including specifically the pulp and the skin as described in the present invention, as amended, and Applicants respectfully request that the Examiner's rejection be withdrawn.

CONCLUSION

Applicants believe that the present claims are patentable over the cited prior art reference. Accordingly, the claims, as amended, are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited. However, if any concerns remain, the Examiner is invited to contact the undersigned if it is believed that it may assist in their resolution.

Respectfully submitted,

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